REMARKS

Twenty-five claims were originally filed in the present Application. Claims 1-25 currently stand rejected under 35 U.S.C. § 102 and 35 U.S.C. § 103. Reconsideration of the Application in view of foregoing amendments and the following remarks is respectfully requested.

Priority Claim

In paragraph 2 of the Office, with regard to the present Application claiming priority in three European Patent Applications, the Examiner states that "[a] claim for priority . . . cannot be based on said application, since the United States application was filed more than twelve months thereafter." However, the Applicant claims priority in the three European patent applications through a PCT patent application that was filed within one year of the three European patent applications.

In particular, the present Application claims priority in PCT Patent Application No. PCT/EP99/04537, entitled "Method To Perform A Scheduled Action Of Network Devices," filed on July 1, 1999, which in turn claims priority in European Patent Application No.98 112 500.8, entitled "Bandwidth Reservation," filed on July 6, 1998, European Patent Application No.98 112 499.3, entitled "Method To Control A Network Device In A Network Comprising Several Devices," filed on July 6, 1998, and European Patent Application No.98 112 501.6, entitled "Method To Perform A Scheduled Action Of Network Devices," filed on July 6, 1998.

Furthermore, the present Application also claims priority in U.S. Provisional Patent Application No. 60/091,812, entitled "Bandwidth Reservation," filed on July 6, 1998 through the same PCT Patent Application No. PCT/EP99/04537 referred to above. Applicant points out that the filing date of Provisional Patent Application 60/091,812 is July 6, 1998, which is exactly the same filing date as the foregoing three European Patent Applications referred to above. Applicant therefore submits that the present Application is entitled to the priority date of July 6, 1998, and respectfully requests the Examiner to acknowledge this claim for priority in the next Office Action.

35 U.S.C. § 102

In paragraph 3 of the Office Action, the Examiner rejects claims 1-5, 9-12, 16, and 21-25 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,712,834 to Nagano et al. (hereafter Nagano). The Applicant respectfully traverses these rejections for at least the following reasons.

"For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference." *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicant submits that Nagano fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

Nagano teaches using control apparatuses to connect various types of network devices (tape recorders, cameras, etc.) in series for transmitting and receiving information and control signals from a computer device (see column 2,

line 65 to column 3, line 2). Nagano is therefore directed toward a physical implementation for connecting and transmitting information between electronic devices.

In contrast, Applicant discloses and claims "calculating an individual triggering time for each device" and "utilizing said individual triggering time for each device . . . to perform said scheduled action." With regard to claim 1, Applicant submits that Nagano nowhere teaches or discloses "calculating an individual triggering time for each device", as recited in claim 1. Furthermore, with regard to claim 21, Applicant recites "a resource manager configured to handle said action invocation information to thereby control one or more network devices to perform said scheduled action." Applicant submits that Nagano nowhere discusses utilizing a resource manager for controlling and performing a scheduled action.

Regarding the Examiner's rejection of dependent claims 2-5, 9-12, 16, and 22-25, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claims 2-5, 9-12, 16, and 22-25 so that these claims may issue in a timely manner.

Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner

fails to cite Nagano to identically teach or suggest the claimed invention, Applicant respectfully requests reconsideration and allowance of claims 1-5, 9-12, 16, and 21-25, so that these claims may issue in a timely manner.

In paragraph 4 of the Office Action, the Examiner rejects claims 1-25 under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,252,886 to Schwager (hereafter Schwager). Applicant respectfully traverses. Both the cited reference to Schwager and the present Application claim the same exact priority date of July 6, 1998. The cited reference to Schwager is therefore not prior art and does not anticipate the present invention under 35 U.S.C. § 102(e). For at least the foregoing reasons, the Applicant therefore respectfully requests the Examiner to withdraw the rejections of claims 1-25 under 35 U.S.C. § 102(e).

Certified Copies Of Priority Documents

The Office Action Summary for the present Office Action states that "[n]one of the certified copies of the priority documents have been received." The Office Action Summary also states "[s]ee attached detailed Office Action for a list of the certified copies not received." Applicant submits that the detailed Office Action contains no such list of certified copies not received. In the event that the foregoing certified copies have not yet been received, the Applicant respectfully requests the Examiner to provide a list of certified copies not received.

35 U.S.C. § 103

In paragraph 6 of the Office Action, the Examiner rejects claims 14 and 15 under 35 U.S.C. § 103 as being unpatentable over Nagano. The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

> "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

With regard to claims 14 and 15, the Examiner concedes that Nagano "does not teach that the network is a home network or 1394-based network." Applicant concurs. However, the Examiner fails to cite additional references to remedy these defects in Nagano. Instead, the Examiner states that "Official Notice" is taken "that these devices are typically associated with home networks . . . ."

Applicant therefore respectfully requests the Examiner to cite specific references in support of these rejections, and failing to do so, to reconsider and withdraw the rejections of claims 14 and 15, so that these claims may issue in a

timely manner. Furthermore, the Court of Appeals for the Federal Circuit has held that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Applicant submits that there is no teaching of a combination that would result in Applicant's invention, and therefore the obviousness rejection under 35 U.S.C §103 is not proper.

Applicant submits that the cited references, in combination with the Official Notice, do not suggest a combination that would result in Applicant's invention, and therefore the obviousness rejections under 35 U.S.C §103 are improper. Applicant therefore respectfully request the Examiner to cite references in support of the Official Notice, and to also indicate where an explicit teaching to combine the cited reference may be found. Alternately, the Applicant requests that the Examiner reconsider and withdraw the rejections of claims 14 and 15 under 35 U.S.C §103.

For at least the foregoing reasons, the Applicant submit that claims 14 and 15 are not unpatentable under 35 U.S.C. § 103 over Nagano, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claims 14 and 15 under 35 U.S.C. § 103.

Summary

Applicant submit that the foregoing remarks overcome the Examiner's rejections under 35 U.S.C. §102 and 35 U.S.C. §103. Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicant therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-25 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicant' undersigned representative at the number provided below.

Respectfully submitted,

Date: 5/24/04

By: _____

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